



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/982,571	10/17/2001	Motoki Kato	450100-4886.1	7985

20999 7590 10/21/2003

FROMMER LAWRENCE & HAUG
745 FIFTH AVENUE- 10TH FL.
NEW YORK, NY 10151

EXAMINER

YOUNG, WAYNE R

ART UNIT PAPER NUMBER

2652

DATE MAILED: 10/21/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/982,571

Applicant(s)

KATO, MOTOKI

Examiner

W. R. Young

Art Unit

2652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-20,22-24,26-28,30-32,34-36 and 38-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-20,22-24,26-28,30-32,34-36 and 38-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 07 March 2002 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/313,100.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 2652

1. The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on 3/7/02 have been approved by the examiner. A proper drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The correction to the drawings will not be held in abeyance.

New formal drawings are required in response to this office action.

2. Applicant's arguments filed 12/20/02 have been fully considered but they are not persuasive.

Applicant argues that the new claims are allowable because they include limitations the Examiner allowed in parent case 09/313,100. First, it is noted that the limitations now claimed are not as specific as those previously allowed by the examiner. Thus, the argument as to patentability is not convincing. Second, the claims in case 09/313,100 were drawn to a reproducing apparatus as shown in figure 12, whereas the claims elected for prosecution in this case in response to the Restriction requirement were drawn to a recording apparatus as shown in figure 7. Applicant should note that filing an RCE merely removed the Finality of the last office action and not the election. The election of the recording apparatus carries forward. Inasmuch as applicant intended to claim the reproducing apparatus, all the current claims would be considered to be clearly drawn to a non-elected invention and the amendment of 12/20/02 held as non-responsive to the previous office action. Inasmuch as applicant intended to claim a combination recording/reproducing apparatus, the current claims as evidenced by at least claim 22 are patentably distinct from the elected recording apparatus that required extracting means and clock generating means not required by the combination evidence claim 22 and the parent 09/313,100 case reproducing apparatus which required additional patentable limitations noted,

Art Unit: 2652

supra. The subcombinations each have separate utility with servo control or camera apparatus. Thus, all the current claims would be considered to be clearly drawn to a non-elected invention and the amendment of 12/20/02 held as non-responsive to the previous office action. Inasmuch as applicant is arguing patentability based on the record of the 09/313,100 case, the current claims should be amended to actually recite the same allowable language as that of the parent case, to recite the recording apparatus as originally elected so as not to be drawn to a patentably distinct invention therefrom, and a Terminal Disclaimer filed. Inasmuch as the claims could be interpreted as still claiming a recording apparatus as originally elected, the following action is made.

3. Claims 19-20 are objected to because they include a typographical error, i.e., a non-underlined addition, on line 1, "reproducing", which should be deleted.

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 19-20, 22, 23-24, 26, 27-28, 31-32, 34, 35-36, 38, and 39-40 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention and/or are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 2652

Claim 22 (claims 26, 34, and 38 recite similar language) recites time-stamp generator, formatting unit, and information generator, all drawn to the recording apparatus shown in figure 7. Claim 22 (claims 26, 34, and 38 recite similar language) also recites, "said information and the arrival time stamp is utilized to control the output of said transport packet" which is not found in the recording apparatus of figure 7. It appears that this feature may read on the reproduction apparatus shown in figure 12. Dependent claims 19-20 (dependent claims 23-24, 27-28, 31-32, 35-36, and 39-40 recite similar language) recite a playback management file not found in figure 7, but which may be in reproducing apparatus figure 14. Thus, the claims are either not adequately disclosed or are misdescriptive of what is disclosed and therefore indefinite.

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 18 and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Adachi et al.

Note the front cover for extractor/extracting 100, clock generator/generating 101-102, time-stamp generator/generating 104, formatting unit/step 105, time-stamp discontinuity information generator/generating 103.

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

Art Unit: 2652

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 18 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admitted prior art in view of Menezes.

The admitted art in the information signal transport art, discloses all the subject matter claimed, except for the claimed time-stamp discontinuity information generator/generating. Note in admitted art figure 2, extractor/extracting 2, clock generator/generating 4, time-stamp generator/generating 5, and formatting unit/step 3.

Menezes in the information signal transport art, discloses time-stamp discontinuity information generator/generating, in order to provide accurate calculation of distances between time codes on either side of discontinuities. Note the abstract, figure 24, and columns 52-55.

It would have been obvious to one of ordinary skill in the art at the time of the invention by applicant to provide time-stamp discontinuity information generator/generating to the admitted art as suggested by Menezes, the motivation being to provide accurate calculation of distances between time codes on either side of discontinuities.

10. Claims 18 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admitted prior art in view of Larson.

The admitted art in the information signal transport art, discloses all the subject matter claimed, except for the claimed time-stamp discontinuity information generator/generating. Note in admitted art figure 2, extractor/extracting 2, clock generator/generating 4, time-stamp generator/generating 5, and formatting unit/step 3.

Art Unit: 2652

Larson in the information signal transport art, discloses time-stamp discontinuity information generator/generating, in order to provide accurate measurement of transit delay related to continuity. Note the abstract, figures 2-6, and columns 52-55.

It would have been obvious to one of ordinary skill in the art at the time of the invention by applicant to provide time-stamp discontinuity information generator/generating to the admitted art as suggested by Larson, the motivation being to provide accurate measurement of transit delay related to continuity.

11. Applicant's arguments filed 8/5/02 have been fully considered but they are not persuasive.

In re pages 6-7, Adachi's phase difference detector 103 does indicate continuity/discontinuity of the time codes noted by applicant to also be disclosed therein.

In re pages 7-8, "discontinuity indicator is **identified in the data**" (emphasis added) is not claimed. Menezes detection of the location and magnitude of the discontinuity admitted by applicant to be disclosed therein does meet the claimed/argued discontinuity indicator.

In re page 8, "discontinuity indicator is **identified in the data**" (emphasis added) is not claimed. Larson's calculation of how long the transit delay is by utilizing time stamps and comparing the calculated delay against a maximum acceptable delay as admitted by applicant to be disclosed therein does meet the claimed/argued discontinuity indicator.

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**


Art Unit: 2652

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to W. R. Young whose telephone and VoiceMail number is (703) 308-1554. If a plurality of attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hoa Nguyen, can be reached on (703) 305-9687.

The appropriate fax phone number for the organization (Group 2650) where this application or proceeding is assigned is (703) 872-9314.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4700 or the Group Customer Service section whose telephone number is (703) 306-0377.



WAYNE R. YOUNG
PRIMARY EXAMINER
ART UNIT 2652

wry/wry
10/16/03